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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

MASON HOFFENBERG,

Petitioner,

—v.—

ABRAHAM L. KAMINSTEIN, Register of Copyrights.

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY BRIEF

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(1)

Respondent attempts to deprecate the importance of the issue (a) by saying that it has not previously been adjudicated (Resp. 20, fn. 18) and (b) by saying that the pertinent statutory provisions are "likely" to be amended by Congress "in the near future" (Resp. 5, 20).

Respondent offers nothing in support of the assertion that amendment is likely or of the guess as to when it might occur. The attempt to effect a revision of the Copyright Act has been going on—without success—for the past decade, and such indications as there may be of future Congressional action contradict the respondent's estimate. (We respectfully refer the Court to the newspaper report cited Pet. 8, first fn. and 9). But, in any case, the present question is not answered by the possibility of future events. The proposed amendments to which respondent refers apply only

prospectively. There are sixty years of writing that will continue to be governed by the current provisions even if these proposals were to become law tomorrow. The importance of the question has been enhanced in recent years, during which the paperback revolution and other developments have increased the number of works now published here that were first published abroad. The rights that hinge on the outcome of the present case (Pet. 6-8) are not affected by such changes in the law as the respondent (quite unrealistically, we suggest) asks the Court to assume are "likely" and "near".

As to the fact that the issue has not been adjudicated, this Court, in one of the relatively few cases in which it has construed the Copyright Act, has made it clear that the absence of prior decision is not a reason for denying certiorari. In *De Sylva* v. *Ballentine*, 351 U.S. 570 (cert. granted 350 U.S. 931), the opinion stated at the outset:

> "* * * Strangely enough, these questions have never before been decided, although the statutory provisions involved have been part of the Act in their present form since 1870." (351 U.S. 570, 572-3.)

Another aspect of the *De Sylva* opinion is apposite here. Petitioner and several *amici* had argued that the interpretation they were urging was "universal." The Court described this as an "overstatement", and ruled the other way, observing that the Copyright Office "recognized [the section's] ambiguity" and that "more than one qualified commentator" had either expressed doubt on the question or come to a different conclusion (351 U.S. 570, 578). The parallel to the present case is striking. Here the Copyright Office has recognized ambiguity by shifting its position; it espoused one interpretation of the statute until

1956 and another, contrary, interpretation after that date (Pet. 25). And the three foremost commentators in the field have all treated the present question as an open one. See Chafee, *Reflections on the Law of Copyright,* 45 Col L. Rev. 503, 528 (1945); Howell, *The Copyright Law* (Third edition 1952) pp. 93-100; *Nimmer on Copyright,* § 96.4, p. 363.2.

(2)

Respondent, conceding that §10 "provides the basic method by which books are copyrighted," goes on to say that §10 "is modified" by §16 (Resp. 5). This, of course, is a conclusion. Section 16 makes no reference to §10. Neither do §§ 22 or 23. Nor does the explicit language of § 10 in any way indicate that its copyright-securing process is limited by any other section of the Act. Copyright is obtained by complying with the first clause of § 10 (as petitioner has done here), unless, wishing to take advantage of the provisions of § 22 in the circumstances it describes, an author chooses to employ this special procedure in place of the "basic method." An ordinary reading of the statute gives the impression (confirmed by legislative history) that the right is established by the first clause of § 10. Other parts of the Act affect the enforcement and continued existence of the right.* Remedies depend on compliance with § 13, and forfeiture of the right will follow from violation of § 16, or from violation of the second clause of § 10 itself. Only in this sense may it fairly be said that § 16 modifies § 10.

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* See S. Rep. No. 6187, 59th Cong. 2d Sess. (1907) pp. 4-5, which includes the following:

> ". . . The protection is to be initiated by this act [of publication with notice] alone, and will not be lost by later omissions, though these may fatally impair the remedy against a particular infringer."

See also H. Rep. No. 7083, 59th Cong. 2d Sess. (1907) p. 8; S. Rep. No. 1108, 60th Cong. 2d Sess. (1909) p. 10.

Petitioner contends—and the contention is supported by the history and purposes of the manufacturing clause, and by the general principle that a statute is not given extra-territorial effect unless the intent to do so is clear—that § 16 applies to the manufacture of books offered for sale in the American market, and not to books offered for sale in foreign markets. Respondent argues that this is "a dramatic curtailment of the domestic-manufacture requirement" (Resp. 8). But this is exactly the scope of the requirement that Congress had in mind (Pet. 18-20). And in fact the Copyright Office interpretation involves a more drastic curtailment, and one inconsistent with Congressional purposes, since its effect is to increase the opportunities for importation of books printed abroad (Pet. 26-27).

No edition after the first edition, says the Copyright Office, need comply with the requirements of § 16. When the brief for respondent states that ". . . Section 16 requires that books to be afforded protection be manufactured domestically . . ." (Resp. 7), it makes a statement inconsistent with the position taken by respondent in the courts below. Petitioner has pointed out that all important American literary works of this century have had subsequent editions published in Great Britain and manufactured there. Respondent has up to now agreed (and we do not read his brief as abandoning this position, despite the quoted statement) that these works must be, and are, "afforded protection" even though they are not "manufactured domestically."* Respondent is unwilling to say that these works are in the public domain, and in this respondent is correct. They are

* Thus, for example, respondent's brief in the Court of Appeals (at p. 43): ". . . foreign editions manufactured abroad . . . would be protected by United States copyright only if a domestically-manufactured edition had been published first." (The word "only", of course, does not affect respondent's position that such foreign-manufactured books are protected.)

not in the public domain because the books manufactured in Great Britain are not offered for sale on the American market. But if petitioner is to be defeated, respondent cannot accept this view, and instead respondent has imported into the statute a non-existent provision to the effect that § 16 has no application to editions other than the first edition.

Respondent now attempts to avoid this difficulty by saying that the determination of rights in these many great works presents a "hypothetical case" which "has no pertinence here" (fn. 6, Resp. 9-10). But the issue presented by the petition is not one that can be so rigidly confined to particular facts. The question is as to the meaning of § 16, and if the section does not mean what petitioner contends, respondent must tell us what it does mean. If the works of Lewis, Hemingway, Faulkner, Dreiser and the others who have been published in Great Britain are not now in the public domain, authors and publishers must know why, and there is no third construction (different from those advanced by petitioner and, hitherto, by respondent) that can account for the result. The petitioner offers a reading of the statute that accounts for it sensibly. Up to now, respondent has rested on his opposing reading; he has not sought to avoid the problem by resorting to the deprecation of a footnote. The questions are inextricable, and we respectfully submit that respondent cannot answer by asking this Court simply to shut its eyes to a problem of this magnitude.*

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* The last sentence of respondent's footnote 6 (Resp. 10) may be contrasted with Congress' own statements on the purposes and effects of the 1909 legislation. See Committee Reports cited pet. 12 and *Washington Pub. Co.* v. *Pearson*, 306 U.S. 30.

(3)

Respondent claims that petitioner's contention "leaves the ad interim provisions without any impact at all" (Resp. 7, 10-11). The petition, urging that the ad interim provisions are, in the circumstances they describe, an alternative route to copyright, mentions that they provide "certain advantages and disadvantages" (Pet. 13). Respondent argues that petitioner has failed to show what they are. We should have thought that they would be clear to the attorneys for respondent, especially since they were spelled out in the brief submitted to the Court of Appeals (and omitted from the petition in the interests of brevity). The petition describes the origins of the ad interim provisions (Pet. 18, 1st fn.) which alone could account for their presence in the Act even if the evolution of the Act during the years 1906-1909 had ultimately deprived them of their earlier significance.* But the fact is that the ad interim provisions continued to have considerable significance, whether petitioner's or respondent's view of the statute is accepted.

As §10 was finally enacted, copyright was granted upon publication-with-notice without restriction as to where the publication might take place. But there were still important roles for §22 to play. One inhered in the publishing practices of the time. British publishers and printers did not manufacture their books with an eye to American copy-

* In addition to what appears on Pet. 18, it may be noted that in the original draft of §10, the publication-with-notice that would secure copyright had to be a publication in the United States, a restriction later abandoned (Pet. 11). Thus if the British author first published his work in England, which would be the normal situation, he could in no event secure United States copyright unless some other provision were made. Section 22 supplied this other provision.

right requirements. American publishers could be expected to have either direct familiarity with notice requirements or advice from American counsel—neither of which British publishers would have. Congress was conscious of these practical considerations. See Arguments before Committee on Patents of Senate and House on S. 6330 and H.R. 19853 (1908) at page 74, and Arguments before Committee on Patents of Senate and House on S. 6330 and H.R. 19853 (1906) at page 55. Additional evidence of this factual situation is supplied by the Copyright Office itself. See Copyright Law Revision Part 6, Supplementary Report of the Register of Copyrights on the general revision of the United States Copyright Law: 1965 Revision Bill, May 1965, pages 100-101 (" . . . foreign publishers sometimes ignore the need to use notice . . .").

In recent years §§ 22 and 23 have been given an important additional function. In 1949 and 1954 provisions were added permitting the importation of a limited number of foreign-manufactured copies if the ad interim method of securing copyright has been followed. These provisions give the publisher a chance to determine whether the work will sell in the United States before undertaking the expense of printing an edition in the United States, something he cannot do without loss of copyright if § 10 has been the source of the right.*

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* As stated by the Register of Copyrights:

". . . An ad interim copyright permits the copyright owner to import up to 1,500 copies of the foreign edition during the 5-year period of ad interim protection, so that he may test the U. S. market and determine whether it would be worthwhile to manufacture an edition in the United States. . . ." (Report of the Register, House Com. Print: 87th Cong. 1st Sess. 1961.)

But the most striking "impact" of the ad interim provisions—an impact made without regard to whether petitioner's or respondent's reading of the statute is accepted—is their effect upon § 13. Section 13 forestalls the pursuit of pirates until there has been deposit of two copies manufactured in the United States in compliance with § 16. Thus if an author rests content with publication-with-notice as his method of obtaining copyright in an English-language work first published abroad, he will have a right without a remedy until he has had an edition manufactured in the United States (an event which may never occur). If, however, he follows the more elaborate procedure prescribed by § 22, he may bring action against infringers prior to the manufacture of an American edition (and, for a period of five years, even if no American edition will ever be manufactured) since §16 contains a specific exemption where §22 has been invoked.*

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* It has been suggested (*Nimmer on Copyright*, §96.4, p. 363.2) that in the case of an English-language work first published abroad, §16 operates to prevent suit forever for infringements that occurred prior to American manufacture—that is, that the failure to manufacture here (apart from making it impossible as a practical matter to comply with the requirements of §13) means that, though copyright exists if there is the proper notice on the publication, infringers may during the earlier period proceed with impunity, the copyright being enforceable only with respect to infringements occurring after the date of American manufacture. Such a construction would of course put an author using the §10 method at a disadvantage as compared with the author using §22; the latter, exempted for five years from the requirements of §16, is in a position to sue for infringements that precede the American manufacture. This construction of §16 is not detrimental to petitioner, since in the present situation the pirates did not bring out their editions until after the American manufacture of an authorized American edition by G. P. Putnam's Sons. At the same time, this construction would require a judgment in petitioner's favor, since it necessarily posits the existence of copyright.

It may be noted, in this connection, that respondent, referring to the phrase "accorded protection" which appears in §16, makes the inaccurate statement that "Obviously, the securing of a copyright brought about by publication with notice under Section 10 affords such 'protection'." (Resp. 7.) There can be no protection unless pirates can be sued, and they cannot be sued until §13 is complied with, by the deposit of American-made copies. Copyright, we submit, is created when there is publication with notice, whether here or abroad, but the remedies available to the holder of the copyright must await the manufacture of an American edition, unless the special copyright-creating process of §22 is employed.

(4)

Respondent seeks to distinguish *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, *United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260, and *Heim* v. *Universal Pictures Co.*, 154 F.2d 480 (C.A. 2) on their facts (Resp. 9; 17, fn. 13). But these cases are not cited for their specific facts. *Washingtonian* is cited to show that the Act of 1909 represented a radical departure from the prior copyright-securing process; that the Act distinguishes between rights and remedies, and that under the new system the securing of copyright depends entirely on publication-with-notice and not at all on any action taken by or with respect to the Copyright Office. *United Dictionary* is cited for two points: (a) the principle that, unless a contrary intent is manifested, statutes are to be read as applying only to events and transactions that take place within our borders, and (b) the petitioner's alternative claim that if the 1958 French publication did not secure copyright, it was later secured by the

1964 American publication. As to the latter, respondent's attempt to distinguish the case (on the ground that "the precise question" was whether copyright once obtained was later lost through violation of the notice provisions) puts a strained meaning upon the concept of "holding", since it entirely ignores the reasoning on which the Court in *United Dictionary* based its decision. *Heim* is cited for the proposition that the copyright-securing process of §10 encompasses publication abroad as well as publication in this country—a proposition on which Judge Learned Hand, Judge Charles Clark and Judge Jerome Frank all agreed, their disagreement being on other issues not relevant to the present case.

(5)

Respondent attempts to meet the constitutional questions raised by petitioner and by *amicus* Authors League by saying that Congress could impose the condition of domestic manufacture and that §16 "by protecting domestic publishers and manufacturers from foreign competition, serves to ensure the continued health of the American publishing industry as a market for American authors" (Resp. 18). We agree that Congress has power to attach conditions that serve such a purpose. And we submit that §16 as construed by petitioner does serve the stated purpose. But §16 as construed by respondent does not. On the contrary, respondent's construction defeats the aim of protecting American printers at the same time that it deprives American authors of their copyrights (Pet. 26-27).

In attempting to dissipate the problem of Constitutional infirmity, respondent refers to a *"quid pro quo"* to justify the discrimination against American authors involved in the Office interpretation (Resp. 19). But the UCC effected

no gain for American authors in the present situation—no *quid pro quo*. Bilateral treaties which gave American authors exactly the same protection as they receive under UCC already existed with each of the countries where an English-language work by an American might possibly appear—Great Britain, France, Germany, Italy and the Scandanavian countries among others. In addition, there was the protection that as a matter of practice flowed from the provisions of the Berne Convention by reason of the usual simultaneous publication in the United States and Canada. It may be noted, moreover, that none of these foreign countries have anything equivalent to our manufacturing clause; it is not as though the foreign countries gave up restrictions upon American citizens in return for America's putting their citizens at an advantage as against American authors.

(6)

Respondent challenges petitioner's contention that the Copyright Office regulation does not represent the kind of agency interpretation to which the courts give weight and that the regulation adds nothing to the statute (Resp. 4, fn. 1). But respondent offers no answer to petitioner's points that (1) the Copyright Office has no legislative or adjudicative functions in this regard, the right of copyright flowing directly from the statute and from the author's or publisher's acts in relation to the statute; (2) the question presented by the petition is purely one of law which the statute entrusts to the courts in the first instance without any prior administrative proceeding; (3) the question is not analogous to those in which an administrative agency is invested

with responsibilities that create an administrative expertise;* (4) the regulation does not represent any contemporaneous or long-continued construction, having been adopted in 1956, long after the 1909 enactment of the statute, and embodying a reversal of earlier Copyright Office practice (Pet. 24-25). Moreover, the brief for respondent completely ignores respondent's concession in the courts below that the regulation is at least in part inconsistent with the Copyright Act. (Pet. 21-22 and fn.). A regulation that concededly conflicts with the statute is hardly a key to the meaning of the statute.

The Copyright Office position on the present question is not only specifically inconsistent with the position the Office took on the same question in the years prior to 1956; it is also inconsistent, in its rigidity, with the loose construction that the Office puts upon the manufacturing clause in its other aspects. Section 16 requires that the text of all copies "shall be printed from type set within the limits of the United States . . . or from plates made within the limits of the United States from type set therein, or, if the text be produced by lithographic process, or photoengraving process, then by a process wholly performed within the limits of

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* Respondent relies on *Bouvé* v. *Twentieth-Century Fox Film Corp.*, 122 F.2d 51, 53-54 (C.A.D.C.). This is one of a group of cases holding that in certain circumstances the Copyright Office has discretion to refuse registration. All of these cases deal with the problem, frequently faced by the Office, whether the object or article as to which registration is sought constitutes copyrightable subject matter. To some extent, of course, these cases require an interpretation of the Copyright Act, but there is an important difference of degree. In the cases cited, the question is mainly factual; a relatively narrow and confined portion of the statute is involved, and the question concerns its application to varying concrete fact-situations. In the instant case, in contrast, the facts are plain and uncontroverted, while the question of law is complex and involves the fundamental statutory structure.

the United States. . . ." Nevertheless, the Office has taken the position that there is no violation of §16 in the following situations: Type is set in a foreign country; pages are printed from the type for reproduction purposes; and the pages are brought into this country and photocopied to make up books for publication and sale in the United States. Or the overseas manufacturing process goes even further, and the photographic negatives, made from the type set abroad, are themselves made abroad and brought into the country. In such situations, the prohibitions of §16, read literally, would seem to have been violated, but the Office nevertheless issues certificates of registration. From the printers' point of view, the Copyright Office construction of the statute in these situations substantially reduces the value of the manufacturing clause and negates its purposes: books are sold on the American market though the typesetting, the most expensive and most important part of the work of manufacturing them, is done abroad. The very thing that the manufacturing clause was intended to prevent—the lessening of work available to American printers through the use of foreign labor on books that enter the American market—is promoted by the Office position. And the Office strains the language of § 16 to accomplish this result.

Conceivably, the Office does this with the notion that it is somehow aiding the preservation of the rights of authors and other copyright proprietors. In contrast, in situations like the present one, the Office strains the language of the section (by reading it as though it contained nonexistent language distinguishing between the first edition and subsequent editions) and in doing this both deprives authors of rights and diminishes the protection that the clause provides for printers (Pet. 26-27).

(7)

Petitioner and respondent differ on the significance of Congressional statements made after the enactment of the statutory provisions that are to be construed. But whatever weight such statements may carry, it can hardly be denied that they must be considered in context. Was the view that respondent ascribes to Congress critical in its consideration of the new legislation? Were the statements respondent relies on made with respect to the issue that the petition presents?

The instant case turns on the meaning of §§10 and 16. Sections 22 and 23 say nothing about whether they were meant to be exclusive or merely an alternative, and in view of the unequivocal language of §10, it would appear that they are no more than an additional route to copyright. Respondent's arguments throughout this litigation have always come ultimately to the point that, in circumstances like the present, §16 deprives the author of rights that §10 would otherwise grant. Sections 22 and 23 thus become exclusive only in the sense that the ad interim procedure is left as the single method of obtaining copyright in these circumstances (if respondent's version of §16 is correct).

But the amendments to which respondent refers, and the Congressional statements made during their consideration, have nothing to do with the question whether the ad interim provisions are exclusive, or—except as they point in a direction opposite to that suggested by respondent—with the scope or applicability of §16. These amendments merely extended the time periods that must be met if the ad interim provisions are to be invoked, and authorized the importation of 1,500 copies when they are invoked. It is not as

though the new legislation depended for its meaning or effect on a particular understanding of the existing legislation. The language quoted from *State Board of Insurance* v. *Todd Shipyards*, 370 U.S. 451 (Resp. 16) is not pertinent. No "assumption" regarding the exclusiveness *vel non* of §§22 and 23 was necessary to the legislative decision; the new provisions were equally desirable or undesirable whether petitioner's or respondent's construction of the statute is correct. Nor did Congress have to make any decision as to whether §16 distinguishes between books to be sold on the American market and books to be sold on the foreign market (as petitioner urges) or (as respondent urges) the section instead distinguishes between first editions and later editions.

But in fact the Committee Reports relied on by respondent embody a view of §16 that supports petitioner, not respondent. Senate Report No. 375, 81st Cong., 1st Sess., which respondent three times cites (Resp. 13; 13, fn. 8; 14), states (at p. 4) that "... the repeal of the manufacturing clause would result in the flooding of *the American market* with the products of cheap foreign labor." (Emphasis supplied.)

House Report No. 238, 81st Cong., 1st Sess., p. 5 (cited at Resp. 14, fn. 8; 14-15) contains the same statement, referring with the same emphasis to the American market.

The letter from the Secretary of State appended to Senate Report No. 375, p. 6 (cited at Resp. 15, fn. 10) contains the following:

> "... the various provisions of title 17 described above are clearly designed to preclude any book in the English language from having copyright protection in the

> United States unless, with a few exceptions, every copy *sold here* is manufactured in the United States." (Emphasis supplied.)

Finally, since respondent puts so much weight on retrospective comment, we ask leave to repeat the statement quoted in the petition from the House Committee Report on the copyright legislation recently considered by Congress:

> "The basic purpose of section 601, *like that of the present manufacturing clause,* is to induce the manufacture of an edition in the United States if more than a certain limited number of copies are *to be distributed in this country* . . ." (H. Rep. No. 83, 90th Cong., 1st Sess., p. 135). (Emphasis supplied.)

In sum, the parts of these Reports that respondent cites tell us only what Congress assumed the ad interim provisions to mean where the ad interim provisions are applicable. In contrast, the statements cited by petitioner tell us the meaning of the manufacturing clause, upon which the solution of the present issue depends.

Respectfully submitted,

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